UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,777	03/28/2006	William F. Rossiter	0579-1121	5523

466 7590 10/24/2008

YOUNG & THOMPSON
209 Madison Street
Suite 500
ALEXANDRIA, VA 22314

EXAMINER	
ANDLER, MICHAEL S	

ART UNIT	PAPER NUMBER
2876	

MAIL DATE	DELIVERY MODE
10/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/573,777	ROSSITER, WILLIAM F.	
	Examiner	Art Unit	
	Michael Andler	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *28 March 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims **4, 7, 8 and 14** are objected to because of the following informalities:

Regarding claim **4**, change “card body” to –microcircuit card—to be consistent with the specification (See page 3, lines 8-9).

Regarding claim **7**, there is no antecedent basis for the element of “the ID-1 format”. Delete the word “the" before ID-1.

Regarding claim **8**, there is no antecedent basis for the element of “the ID-000 format”. Delete the word “the” before ID-000.

Regarding claim **14**, there is no antecedent basis for the limitation of "the contactless type". Delete “of the" and substitute it with --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a) Claims **1-8, 13-14 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Lind et al. (WO 02/066226).

Regarding claim **1**, Lind et al. discloses a card comprising:

a body (Fig 7a: *carrier card* (not labeled)) with a precut (See Fig 7a, item 301: *grooves*) microcircuit card (Fig 7a, item 201: *SIM module*),

characterized in that a token (Fig 7a, item 200: *optical disc*) is also precut (See Fig 7a, item 303: *grooves*) in the body of the card next to the microcircuit card.

Regarding claim **2**, Lind et al. discloses that the token extends to a corner of the card body (See Fig 7a, where it is clear that the *optical disc 200* extends to the outer corners of the *carrier card* at the lower part of the figure).

Regarding claim **3**, Lind et al. discloses that the token extends to only one corner of the card body (See Fig 7a, where it is clear that the circular portion of the *optical disc 200* extends to an inner corner of the *card carrier* near the notch in the *SIM module 201*).

Regarding claim **4**, Lind et al. discloses that the token extends to the corner at the greatest distance from the card body (See Fig 7a, where it is clear that the *optical disc 200* extends to the lower left corner of the *carrier card*).

Regarding claim **5**, Lind et al. discloses that the token has sides at least approximately parallel to those of the card body (See Fig 7a, item 702: *diagonal* where it is understood that the *optical disc 200* is in the shape of a rectangle and the 2 sides created by the *groove 303* are parallel to the outside edge of the *card carrier*).

Regarding claim **6**, discloses that the token has sides at least approximately aligned with the sides of the microcircuit card (See Fig 7a, item 702: *diagonal* where it is understood that the *optical disc 200* is in the shape of a rectangle and "to align" is defined as "to place in a line or arrange so as to be parallel").

Regarding claim **7**, Lind et al. discloses that the card body conforms to the ID-1 format (See Page 3, line 11: "*an ISO 7810 standard card*" and page 2, lines 28-29:

"*where the carrier according to this standard has a length of 85.6 mm and a width of 53.9 mm*" and page 16, lines 17-18: "*the carrier SIM card…with the SIM plug 201 may be installed in some cellular telephones*").

Regarding claim **8**, Lind et al. discloses that the microcircuit card conforms to the ID-000 format (See Page 3, line 11: "*placement of the SIM module on an ISO 7810 standard card*" and lines 2-3: "*the configuration of the electronic circuit is governed by…ISO 7816*" and page 16, lines 18-19: "*the SIM plug 201 itself may be detached…for installation into other cellular telephones*").

Regarding claim **13**, Lind et al. discloses that the token is connected to the remainder of the card body by mechanically weakened areas consisting of grooves (Fig 7a, item 303: *grooves*).

Regarding claim **14**, Lind et al. discloses that the token is of the contactless type (See Fig 7a, item 200: optical disc where it is well known in the art that optical discs operate on reflected light from a laser diode and are therefore contactless).

Regarding claim **16**, Lind et al. discloses that the token has sides at least approximately parallel to those of the card body (See Fig 7a, item 702: *diagonal* where it is understood that the *optical disc 200* is in the shape of a rectangle and the 2 sides created by the *groove 303* are parallel to the outside edge of the *card carrier*).

b) Claims **1-3, 5-9, 13 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (US 5,581,065).

Regarding claim **1**, Nishikawa et al. discloses a card comprising:

a body (Fig 21A, item 10C: *sheet-framed IC carrier*) with a precut (See Fig 21A, item 17A: *peripheral slits*) microcircuit card (Fig 21A, item 11A: *IC carrier*),

characterized in that a token (Fig 21A, item 11B: *IC carrier*) is also precut in the body of the card (See Fig 21A, item 17B: *peripheral slits*) next to the microcircuit card.

Regarding claim **2**, Nishikawa et al. discloses that the token extends to a corner of the card body (See Fig 21A where it is clear that *IC carrier 11B* extends to the upper right portion (corner) of the sheet-framed *IC carrier 10C*).

Regarding claim **3**, Nishikawa et al. discloses that the token extends to only one corner of the card body (See Fig 21A where it is clear that *IC carrier 11B* extends only to the upper right portion (corner) of the sheet-framed *IC carrier 10C*).

Regarding claim **5**, Nishikawa et al. discloses that the token has sides at least approximately parallel to those of the card body (See Col 17, lines 54-58: "*the terminals are preferably located at positions compliant with ISO…defined as follows from the left edge or the upper edge of card base*" where the sides of are understood to be parallel in an ISO compliant IC carrier).

Regarding claim **6**, Nishikawa et al. discloses that the token has sides at least approximately aligned with the sides of the microcircuit card (Col 17, lines 29-30: "*The IC carriers 11A, 11B are arranged in line symmetry with each other*").

Regarding claim **7**, Nishikawa et al. discloses that the card body conforms to the ID-1 format (See Col 17, lines 54-55: "*the terminals are...located at positions compliant with ISO*" where it is understood that the dimensions of the *sheet-framed IC carrier 13* would also be compliant with ISO in order to properly position the terminals in a reader).

Regarding claim **8**, Nishikawa et al. discloses that the microcircuit card conforms to the ID-000 format (See Fig 2 and Col 7, lines 12-13: "*sized in the height Y1 of about 15.00 mm by the width X1 of about 25.00 mm*").

Regarding claim **9**, Nishikawa et al. discloses that the token carries visual information (Fig 34, item 17b: *information indicating layer*).

Regarding claim **13**, Nishikawa et al. discloses that the token is connected to the remainder of the card body by mechanically weakened areas consisting of grooves (See Fig 21A, item 17B: *peripheral slits*).

Regarding claim **16**, Nishikawa et al. discloses that the token has sides at least approximately parallel to those of the card body (See Col 17, lines 54-58: "*the terminals are preferably located at positions compliant with ISO…defined as follows from the left edge or the upper edge of card base*" where the sides of are understood to be parallel in an ISO compliant IC carrier).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

a) Claims **9, 10 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lind et al. (WO 02/066226) in view of Dilday et al. (US 2003/0132300).

Regarding claims **9, 10 and 17-20**, Lind et al. teaches an optical disc with a detachable module that discloses all the limitations of claims **1-3 and 4**, respectively. Lind et al. also suggests that "a general aim…is to observe the ISO 7810 standard…(which) governs the position for the placement of the SIM plug" (Page 2, lines 25-27) and that the SIM plug "may also be a pay card…in order to be able to pay for goods or services" (Page 9, lines 31-32).

Dilday et al. teaches a data storage card "that is a size and shape similar to conventional credit cards" (Section 0076, lines 3-4) and suggests that "there is a need for a data storage card that incorporates both a magnetic strip and an annular optical region" (Section 0018, lines 1-3). Dilday also suggests that "the measurement from first longitudinal edge 8 to second longitudinal edge 40 is preferably 85.6 mm, but may be any measurement as long as the functionality of the magnetic and optical data regions are not affected" (Section 0076, lines 13-16).

Lind et al. does not specifically teach that the *optical disc 200* includes a magnetic strip for storing information and that the disc carries visual information.

Dilday et al. discloses an optical disc (Fig 2, item 38: *optical region*) in a card body (Fig 1, item 10: *card body*) that includes a magnetic strip for storing information (Fig 1, item 18: *second linear magnetic data region*) and that the disc carries visual information (Fig 1, items 24: *designated artwork area* and section 0078, line 8: "*a company logo*").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include magnetic strip and a company logo on an optical disc in

a credit card-sized carrier card in order to provide "an access card…which may be read/written by industry standard optical drives and ATM machines" (Dilday et al., section 0018, lines 7-10).

b) Claims **11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lind et al. (WO 02/066226) in view of Pentz et al. (US 6,471,127).

Regarding claims **11 and 12**, Lind et al. teaches an optical disc in the form of a small card that discloses all the limitations of claim **1**. Lind et al. also suggests that the user may remove the *optical disc 200* from the carrier card "in order to learn about the module and its installation (for example)…software packages necessary for Internet access from a mobile or stationary telephone" (Page 10, lines 6-10) which suggests that the device will be transported, most likely in a wallet.

Pentz et al. suggests an invention that "relates generally to data cards…that contain a magnetic stripe or other means of storing information (and) more particularly…to such cards that are small in size" (Col 1, lines 32-35).

Lind et al. does not specifically teach that the *optical disc 200* includes a hole through which a key-ring may be passed and that the hole is in a corner of the *disc* in the vicinity of the *SIM plug*.

Pentz et al. discloses a card that includes a hole through which a key-ring may be passed and that the hole is in a corner of the token in the vicinity of the microcircuit card (Fig 2A, item 22: *hole* where it is understood that it is an engineering choice to place the hole in the vicinity of the *SIM plug 201*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include a hole for a key chain in a small optical disc card, in order to "allow it to be stored in a separate location from conventionally sized cards" (Pentz et al, Abstract, lines 3-4).

c) Claims **4, 10 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065).

Regarding claim **4**, Nishikawa et al. discloses all the limitations of claim **3**. In addition, Nishikawa et al. discloses various embodiments of IC carriers having a plurality of IC modules that are fastened in various methods in Figures 19A-22A. Nishikawa et al. also suggests the invention “may have various modifications with the range not departing the essence thereof” (Col 18, lines 12-13) and that “surfaces of terminals of IC modules 12 may be set on a same plane” (Col 18, lines 13-14).

Nishikawa et al. does not specifically teach in one embodiment that the *IC carrier 11B* (token) extends to the corner at the greatest distance from the card body.

Nishikawa et al. does disclose another embodiment where the *IC carrier 11B* (token) extends to the corner at the greatest distance from the card body (See Fig 22A, where it is clear that the *IC carrier 11B* extends to the lower right portion (corner) of the sheet-framed *IC carrier 10C*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to position a second *IC carrier* in the corner opposite from the first

IC carrier in order to have the terminals "located at positions compliant with ISO" when the terminals of the modules are set in the same plane (Col 17, lines 54-55).

Regarding claims **10 and 17-20**, Nishikawa et al. discloses all the limitations of claims **1-5**, respectively. Nishikawa et al. also suggests the invention "may have various modifications with the range not departing the essence thereof" (Col 18, lines 12-13).

Nishikawa et al. does not specifically teach in one embodiment that the *IC carrier 11B* (token) includes a magnetic strip for storing information.

Nishikawa et al. does disclose another embodiment where the *IC carrier* (token) includes a magnetic strip for storing information (Fig 39, item 75: *magnetic layer*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include a magnetic layer on a *sheet-framed IC carrier* in order to store "information concerning the subscriber of SIM" (Col 28, lines 6-7).

d) Claims **11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) in view of Ross et al. (US 2005/0230485).

1) Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding claims **11 and 12**, Nishikawa et al. discloses all the limitations of claim **1**. Nishikawa et al. also suggests an ISO compliant IC carrier with a plurality of IC modules that conform to ID-000 standards for use in telephones (See above related

arguments, Col 17, lines 54-55, and Fig 47A). Nishikawa also suggests "that a plurality of related IC carriers are produced…such as for…a set of mobile phone and portable phone" (Col 17, line 66 through Col 18, line 2).

Ross et al. suggests an invention that "is a small form factor smart card conforming to industry standard ISO 7816" (Section 0012, lines 1-3).

Nishikawa et al. does not specifically teach that the *IC carrier 11B* includes a hole through which a key-ring may be passed and that the hole is in a corner of the token in the vicinity of the microcircuit card.

Ross et al. discloses a card (token) that includes a hole through which a key-ring may be passed and that the hole is in a corner of the token in the vicinity of the microcircuit card (See Fig 6, item 42: *opening* where it is clear that the opening would be in the vicinity of the *IC carrier 11A* if placed on the *sheet-framed IC carrier* in the location of *IC carrier 11B*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include an opening on an *IC carrier* so "the card can be attached to a keychain for portability and use" (Ross et al., section 0013, lines 6-7).

e) Claims **14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) in view of Luu (US 6,978,940).

Regarding claims **14 and 15**, Nishikawa et al. discloses all the limitations of claim **1**. Nishikawa et al. suggests an ISO compliant IC carrier with a plurality of IC modules that conform to ID-000 standards for use in telephones (See above related arguments,

Col 17, lines 54-55, and Fig 47A). Nishikawa also suggests “that a plurality of related IC carriers are produced…such as for…a set of mobile phone and portable phone” (Col 17, line 66 through Col 18, line 2).

Luu suggests that “a carrier card 20 may be provided with two or more modules 10 (that)...may be provided on both major surfaces of carrier card 20 or all on one side" (Col 7, lines 19-22).

Nishikawa et al. does not specifically teach that the *IC carrier 11B* (token) is of the contactless type and is a radio-frequency identification label.

Luu discloses a token that is of the contactless type and is a radio-frequency identification label (Fig 5, item 10: *contactless transaction module*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include a contactless transaction module on a *sheet-framed IC carrier*, in order to provide "a contactless transaction card in a size which is easily and conveniently stored in a designated holder" (Luu, Col 3, lines 9-10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385. The examiner can normally be reached on Monday-Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Andler/
Examiner, Art Unit 2876